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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/343,943	06/30/99	KNOWLTON E	16904-738

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EXAMINER	
GIBSON, R	
ART UNIT	**PAPER NUMBER**
3739	4

DATE MAILED: 03/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/343,943	Applicant(s) KNOWLTON, EDWARD W.	
	Examiner Roy D. Gibson	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☐ Responsive to communication(s) filed on *07 September 1999* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) *13-22 and 31-33* is/are allowed.

6)☐ Claim(s) *1,3,5,6,9-12,26-30 and 34* is/are rejected.

7)☐ Claim(s) *2,4,7,8,23-25 and 35* is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

1.☐ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) ☒ Notice of References Cited (PTO-892)
15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
17) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
18) ☐ Notice of Informal Patent Application (PTO-152)
19) ☐ Other: .

DETAILED ACTION

Claim Objections

Claims 9 and 10 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 26 and 27. Claims 11and 12 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 28 and 29. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 28 is objected to because of the following informalities: in line 1, "of " should be "at".

Claim 31 is objected to because of the following informalities: in line 10 "int he" should be "in the".

Claim 34 is objected to because of the following informalities: in line 6 "int he" should be "in the" and in line 8, "a" should be "and". Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 30 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,919,219. Although the conflicting claims are not identical, they are not patentably distinct from each other because an RF energy delivery device is an obvious type of thermal energy delivery device.

Claim Rejections - 35 USC § 112

Claims 1, 11, 28 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the membrane" in line 5. There is insufficient antecedent basis for this limitation in the claim. The examiner has assumed that the membrane is the fluid delivery member for purposes of applying prior art.

Claims 11 and 28 recite the limitation "device" in line 2. There is insufficient antecedent basis for this limitation in the claim. The examiner assumes that "device" should be replaced by "member".

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such

omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the focussing element is recited but it is unclear where it is positioned or to what other element it is connected in order to focus something, but what ?.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6, 9-12 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Vaguine et al. (4,556,070).

As to claim 1, Vaguine et al. disclose a skin treatment apparatus, comprising:

a fluid delivery member (Figure 1, fluid enclosure # 24) with a tissue interface surface (flexible member # 42) that remains conformable to a skin surface as the tissue interface surface is applied to a surface of the skin; and

thermal energy delivery device (microwave antenna elements # 18) coupled to the fluid delivery member in a position to transfer thermal energy to an electrolytic media (water) that passes through the fluid delivery member (col. 2, line 49-col. 3, line 40 and col. 4, lines 39-59). Note that the energy source can be microwave or ultrasound or both.

As to claim 3, Vaguine et al. disclose that the thermal energy delivery device is positioned at an exterior surface of the fluid delivery member (Figure 1).

As to claims 6, 9 and 26, Vaguine et al. further disclose a fluid passage lumen which contains a cooling fluid (Figure 1, lines between 30 and 24) coupled to the fluid delivery member.

As to claims 10-12 and 27-29, Vaguine et al. further disclose a sensor (temperature sensor not shown) coupled to the fluid delivery member, positioned at the tissue interface surface and the signal from the sensor is provided to a feedback device (32 and 34) coupled to the energy delivery device, the feedback device being responsive to the temperature and providing a controlled delivery of thermal energy (col. 2, line 62-col. 3, line 30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vaguine et al. in view of Weiss (5,507,790). Vaguine et al. disclose a thermal energy deliver device comprising a microwave or ultrasonic source, but lack the specific disclosure of an RF source. However, Weiss discloses an electromedical apparatus for reducing

subcutaneous fat tissue deposits by heating them with a microwave, ultrasonic or RF source, i.e., these sources are alternative equivalents (abstract and col. 9, lines 8-25). Therefore, to replace the microwave source of Vaguine with an RF source and electrode, as taught by Weiss, would have been obvious to a skillful artisan, since these sources of energy are well known in the art as alternative equivalents.

Allowable Subject Matter

Claims 13-22 and 31-33 are allowed.

Claims 2, 4, 7, 8, 23-25 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 34 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lax et al. (5,458,596) disclose a method and apparatus for controlled contraction of collagen on the skin and in the body, but the electrode is made of metal and, therefore, the fluid delivery member (Figure 9) is interpreted as not being conformable to a skin surface; and Dittmar et al. (4,528,991) disclose a MW applicator for creating local hyperthermia, but the fluid delivery is not conformable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 703-308-3520. The examiner can normally be reached on M-F, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

March 15, 2001

Roy Gibson
Patent Examiner
Art Unit 3739